

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Philip S. Siegel
Serial No.: 09/817,353
Filing Date: March 26, 2001
Group Art Unit: 3627
Examiner: Mussa A. Shaawat
Confirmation No.: 4525
Title: SYSTEM AND METHOD FOR SINGLE-ACTION RETURNS
OF REMOTELY PURCHASED MERCHANDISE

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

REPLY BRIEF

Pursuant to 37 C.F.R. § 1.193, Appellant respectfully files this Reply Brief in response to the Examiner's Answer dated September 3, 2009.

Arguments

Claims 1-2, 4-6, 9, 35-41, and 44-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,980,862 issued to Arganbright et al. ("*Arganbright*") in view of U.S. Patent No. 6,246,997 issued to Cybul et al. ("*Cybul*"). Claims 3, 7-8, and 42-43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Arganbright* in view of *Cybul* in further view of U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. ("*Roman*") and official notice. For at least the following reasons, Appellant respectfully submits that these rejections are improper and should be reversed by the Board. Appellant addresses independent Claims 1 and 46 and dependent Claims 35, 39, 41, and 44 below.

Appellants filed an Appeal Brief on April 14, 2009, and a corrected Appeal Brief on May 20, 2009, explaining clearly and in detail why Claims 1-9, and 35-46 are allowable over the prior art cited by the Examiner in the Final Office Action dated November 19, 2008. Specifically, Appellants demonstrated that at least independent Claims 1 and 46 and dependent Claims 35, 39, 41, and 44 are allowable over the cited references. While Appellants appreciate the Examiner's thoughtful consideration of this case and the Examiner's response in the Examiner's Answer dated September 3, 2009, Appellants respectfully submit that these rejections continue to be improper and should be reversed by the Board.

I. Claims 1-2, 4-6, 9, 35-41, and 44-46 are Patentable under 35 U.S.C. § 103(a) over the *Arganbright-Cybul* Combination

In the Appeal Brief, Appellants demonstrated that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest the combination of elements recited in Appellants' claims.

- A. The proposed combination does not disclose, teach, or suggest "*in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection*"**

comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing.”

For example, Appellants demonstrated that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest “in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing,” as recited in Claim 1. In the *Examiner’s Answer*, the Examiner continues to point to the *Cybul* for disclosure of the recited claim elements. (*Examiner’s Answer*, page 9). Appellants continue to respectfully disagree.

Appellant’s claim recites a specific order to and interrelation between the steps of the claimed method. Specifically, Claim 1 recites that listing of merchandise having purchased by the customer is displayed to the customer. Claim 1 then recites that a click on a particular item of merchandise within the listing is received from a customer and that this click identifies an item for return. In contrast, the cited portion of *Cybul* merely discloses:

A POS system that supports a frequent shopper or loyalty program, a database of loyalty customers, a database of historical purchase data indexed by loyalty customer, a client/server query interface and a list builder tool with an on-line shopping history database together enable a list builder tool to efficiently find and select the past history of respective shoppers and import that data to the list builder’s on-line historical purchase list database, thereby making it available for the shoppers’ first and subsequent on-line shopping experiences.

(*Cybul*, col. 4, lines 25-35). Thus, the selection referred to by *Cybul* is performed by a server-based “list builder tool.” The selection is not by the customer, via a web access tool. The selection is not a click on the particular item of merchandise. And, the selection does not identify a particular item of merchandise for returns processing. In fact, *Cybul* does not at all relate to returns processing. Accordingly, *Cybul* does not disclose, teach, or suggest “in response to and after displaying the transaction history, receiving **an electronic selection, generated by the consumer** on the computerized system associated with the consumer, of **a**

particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and **identifying the particular item of merchandise for returns processing**,” as recited in Claim 1. Accordingly, the recited claim elements are absent from the disclosures of *Arganbright* and *Cybul*.

Additionally, it continues to be Appellants position that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Arganbright* in view of *Cybul* to include an electronic selection from a displayed list of items to the consumer to identify an item for returns processing. *Arganbright* discloses that the process for handling returns begins when “the system presents the user with a copy of the satisfaction guarantee 2702.” (*Arganbright*, Column 63, lines 3-5). Thus, the process initiates with the presentation of the return policy to the user. “After the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to “return” or “exchange” (box 2704) an item or plurality of items.” (*Arganbright*, Column 63, lines 8-11). Thus, the first electronic request received from the user relating to the return of a product is the selection of either a “return” button or an “exchange” button. However, this selection is received only after the customer views the return policy. The selection does not identify an item for return.

Arganbright then discloses that “[i]f the user selects “return,” an online return form 2706 is presented to the user.” (*Arganbright*, Column 63, lines 12-13). “The user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number.” (*Arganbright*, Column 63, lines 13-17, emphasis added). Once the return form is populated by the customer’s input, the return form is “presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user’s computer” and that the user “is requested to print the form and include the form in the box containing the product or products to be returned.” (*Arganbright*, Column 63, lines 23-29). Thus, the form must be filled out by the customer and the transaction information is provided in the box of merchandise returned by the customer. Nothing is presented to the user that would be appropriate for selection by a click on a particular item of merchandise to identify that item for returns processing.

Even when considered in conjunction with the disclosure of *Cybul*, Appellant’s claim language would not have been obvious to one of ordinary skill in the art since *Cybul* merely

discloses that a shopper's purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper's subsequent purchases on-line. At most the *Arganbright-Cybul* combination discloses that during an online purchase, a customer's in store purchases may be used to efficiently develop an on-line shopping list. If an item were needed to be returned after the purchase is complete, the proposed combination merely discloses that a return form could be obtained on-line and filled out by the customer on the customer's computer, as disclosed in *Arganbright*. The form would then be printed and placed in the box for shipping. It would not have been obvious to one of ordinary skill in the art to modify the return process of *Arganbright* and the purchase process of *Cybul* to result in Appellant's recited step of "in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing," as recited in Claim 1.

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 4-6, 9, 36-38, 40, and 45 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claim 46.

- B. The proposed combination does not disclose, teach, or suggest "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server."**

For example, Appellants demonstrated that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server," as recited in Claim 1. In the *Examiner's Answer*, the Examiner continues to point to *Arganbright* for disclosure of a

selection of an item and an electronic request to initiate return processing but points to *Cybul* for disclosure of the electronic selection form a list of merchandise. (*Examiner's Answer*, page 10). Appellants continue to respectfully disagree.

Appellants' claim recites a specific order to and interrelation between the steps of the claimed method. Specifically, Claim 1 recites that a click on a particular item of merchandise previously purchased by a customer is first received from a customer. Then, in response to that click, a returns process for the selected item of merchandise is initiated by a returns server. This combination of operations is not disclosed in the proposed *Arganbright-Cybul* combination. Additionally, Appellant's claim does not merely recite receiving from the consumer an electronic request to initiate return processing. Appellant's claim recites "initiating a returns process for the particular item of merchandise . . . **by a returns server**," and this operation is not disclosed in the proposed *Arganbright-Cybul* combination.

In the Examiner's Answer, the Examiner states that *Arganbright* teaches receiving a selection of an item . . . comprising either return or exchange of an item . . ." (*Examiner's Answer*, page 10). However, *Arganbright* merely discloses that "[a]fter the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (Column 63, lines 8-11). Thus, this portion refers to the selection of either a "return" button or an "exchange" button by a user. Appellants point out that the selection of the "return" button occurs before the user populates the form and **before the user identifies a product by sku # for return**. (Column 63, lines 12-22). As a result, the selection of the "return" button occurs before an item of merchandise is identified for return. Thus, the selection is not selection of an item for return. The mere presentation of form before the identification of the product to be returned is not analogous to "initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server," as recited by Appellant's amended Claim 1. Further, because there is no disclosure in *Arganbright* of any returns processing being initiated after the form is populated, the system of *Arganbright* cannot be said to perform any returns processing. *Arganbright* merely discloses that the form may be printed and included in the package being returned. Appellants find no disclosure of returns processing by a returns server in *Arganbright*.

Appellant also notes that *Cybul* does not at all relate to a returns process or to the processing of returns of merchandise. Even more troubling, as shown above in Section I(A) of this Response, *Cybul* does not even disclose the recited “electronic selection comprising the click on the particular item of merchandise” from the customer. The M.P.E.P. provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Because of the deficiencies of these references and the deficiencies of their proposed combination, Appellants respectfully submit that the piecemeal rejection of Appellant’s claim over the proposed *Arganbright-Cybul* combination fails to give credence to the particular combination of claim elements and the sequence of claim steps specifically recited in Appellant’s claim.

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 4-6, 9, 36-38, 40, and 45 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claim 46.

C. The proposed combination does not disclose, teach, or suggest “*in response to receiving the electronic request from the computing system associated with the consumer, gathering transaction history data associated with the consumer from a computerized database.*”

For example, Appellants demonstrated that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest “in response to receiving the return request from the customer, gathering transaction history data associated with the customer from a computerized database,” as recited in Claim 1. In the *Examiner’s Answer*, the Examiner continues to point to *Cybul* for disclosure of a selection of an item and an electronic request to initiate return processing but points to *Cybul* for disclosure of the electronic selection form a list of merchandise. (*Examiner’s Answer*, pages 10-11). Appellants continue to respectfully disagree.

Appellants’ claim recites a specific order to and interrelation between the steps of the claimed method. First, a return request is received via the Internet. Then, in response to that return request, transaction history data associated with the customer is gathered from a computerized database. Appellant respectfully submits that the proposed *Arganbright-Cybul*

combination does not disclose, teach, or suggest the features and operations recited in Appellants' claim.

Rather, *Cybul* relates to a "a frequent shopper or loyalty program". (*Cybul*, Column 4, lines 25-34; Column 1, lines 63-65; Abstract). As a result, a list builder tool can "efficiently find and select the past shopping history of respective shoppers and import that data to the list builder's on-line historical purchase list database, thereby making it available for the shoppers' first and subsequent on-line shopping experiences." (*Cybul*, Column 4, lines 29-34; Abstract). As such, although *Cybul* discloses "access[ing] a customer's shopping history from a selected POS system" (*Cybul*, Column 4, lines 40-50), *Cybul* merely discloses that a shopper's purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper's subsequent purchases on-line. *Cybul* does not at all relate to a returns process and, thus, does not disclose, teach, or suggest gathering transaction history data associated with the customer from a computerized database "*in response to receiving the electronic request from the computing system associated with the consumer.*"

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 4-6, 9, 36-38, 40, and 45 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claim 46.

II. Claim 35 is Allowable under 35 U.S.C. § 103(a) over the *Arganbright-Cybul* Combination

In the Appeal Brief, Appellants demonstrated that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest the combination of elements recited in Appellants' dependent Claim 35. Specifically, Appellants demonstrated that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "completing the returns process based upon settings in the consumer preference profile," as recited in Claim 35. In the *Final Office Action*, the Examiner relied specifically upon *Arganbright* for disclosure of the recited claim elements. (*Final Office Action*, page 6). However, in the *Examiner's Answer*, the Examiner points to *Cybul* but cites portions of *Arganbright*. (*Examiner's Answer*, pages 12-13). Since *Cybul* does not at all relate to returns processing, Appellants assume that the Examiner's reliance upon *Cybul* is a typographical error and that the Examiner intended to rely

upon *Arganbright* and its corresponding citations. Appellants respectfully disagree, however, that *Arganbright* discloses the recited claim elements.

Arganbright merely discloses a program that “tracks a Member’s shopping history.” (*Arganbright*, Column 65, lines 7-10). According to *Arganbright*, once a shopper completes the payment information and submits the order during an initial purchase, an email notification is sent to the consumer, and the email may include details such as “order status, order number, line item details, sub totals, tax shipping, service charges, and a grand total” as well as “shipping/billing information” and “a link that allows the user to view order details.” (*Arganbright*, Column 62, lines 31-44). The disclosed email notification is not at all related to a returns process and certainly does not include “retrieving a preference profile for the identified customer” and “completing the returns process based upon settings in the consumer preference profile,” as required by Claim 35.

In the case of a return, it is handled “via an online form.” (*Arganbright*, Column 62, lines 57-59). According to *Arganbright*, the process initiates with the presentation of the return policy to the user. “After the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to “return” or “exchange” (box 2704) an item or plurality of items.” (*Arganbright*, Column 63, lines 8-11). Thus, the first electronic request received from the user relating to the return of a product is the selection of either a “return” button or an “exchange” button. “If the user selects “return,” an online return form 2706 is presented to the user.” (*Arganbright*, Column 63, lines 12-13). “The user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number.” (*Arganbright*, Column 63, lines 13-17, emphasis added). Once the return form is populated by the customer’s input, the return form is “presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user’s computer” and that the user “is requested to print the form and include the form in the box containing the product or products to be returned.” (*Arganbright*, Column 63, lines 23-29). Thus, the form must be filled out by the customer and the transaction information is provided in the box of merchandise returned by the customer. There is no disclosure in *Arganbright* or the *Arganbright-Cybul* combination of “retrieving a preference profile for the identified customer” and “completing the returns process based upon settings in the consumer preference profile,” as required by Claim 35.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claim 35.

III. Claim 39 is Allowable under 35 U.S.C. § 103(a) over the *Arganbright-Cybul* Combination

In the Appeal Brief, Appellants demonstrated that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest the combination of elements recited in Appellants' dependent Claim 39. For example, the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "receiving transaction history data from a retailer on a periodic basis," as recited in Claim 39. In the *Final Office Action*, the Examiner relied specifically upon *Arganbright* for disclosure of the recited claim elements. (*Final Office Action*, page 5). However, in the *Examiner's Answer*, the Examiner points to *Cybul* but seems to be citing portions of *Arganbright*. (*Examiner's Answer*, page 11). Based on the citations, Appellants assume that the Examiner's reliance upon *Cybul* is a typographical error and that the Examiner intended to maintain his reliance upon *Arganbright*. Appellants respectfully disagree, however, that *Arganbright* discloses the recited claim elements..

The cited portion of *Arganbright* merely discloses a client/server system in which a customer can purchase items from a product list 90. (*Arganbright*, Column 48, lines 1-65). According to *Arganbright*, "in order to select a product for purchase, a user fills in a quantity 92 on product list 90." (*Arganbright*, Column 48, lines 33-34). "Upon selecting the quantities for purchase for a plurality of products, the user can then initiate the Add to Basket link 94, by double clicking a mouse, for example, to add the selected products to a shopping basket." (*Arganbright*, Column 48, lines 35-38). Thus, the cited portion of *Arganbright* merely relates to the purchasing of an item by a consumer by adding items from a product list to a virtual shopping basket. As such, it continues to be Appellants' position that there is no disclosure in the cited portion or in any other portion of *Arganbright* of "receiving transaction history data **from a retailer on a periodic basis**," as recited in Claim 39.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claim 39.

IV. Claim 44 is Allowable under 35 U.S.C. § 103(a) over the *Arganbright-Cybul* Combination

In the Appeal Brief, Appellants demonstrated that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest the combination of elements recited in Appellants' dependent Claim 44. For example, the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "determining if the selected item of merchandise is perishable," as recited in Claim 44. In the *Examiner's Answer*, the Examiner continues to rely specifically upon *Arganbright* for disclosure of the recited claim elements. (*Examiner's Answer*, page 11). Appellants respectfully disagree.

Arganbright merely discloses a process for handling returns that begins when "the system presents the user with a copy of the satisfaction guarantee 2702." (*Arganbright*, Column 63, lines 3-5). Thus, the process initiates with the presentation of the return policy to the user. "After the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (*Arganbright*, Column 63, lines 8-11). Thus, the first electronic request received from the user relating to the return of a product is the selection of either a "return" button or an "exchange" button. "If the user selects "return," an online return form 2706 is presented to the user." (*Arganbright*, Column 63, lines 12-13). "The user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number." (*Arganbright*, Column 63, lines 13-17, emphasis added). Once the return form is populated by the customer's input, the return form is "presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user's computer" and that the user "is requested to print the form and include the form in the box containing the product or products to be returned." (*Arganbright*, Column 63, lines 23-29). Thus, the cited portion of *Arganbright* merely discloses a form that must be filled out by the customer and placed in the box with the merchandise returned by the customer. At most, *Arganbright* discloses the customer identifying the reason for the return. However, there is no disclosure in the cited portion or in any other portion of *Arganbright* that initiating the return process comprises "determining if the selected item of merchandise is perishable," as recited in Claim 44.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claim 44.

V. Claim 41 is Allowable under 35 U.S.C. § 103(a) over the *Arganbright-Cybul* Combination

In the Appeal Brief, Appellants demonstrated that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest the combination of elements recited in Appellants' Claim 41.

- A. The proposed combination does not disclose, teach, or suggest “*in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing.*”**

For example, Appellants demonstrated that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest “in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing,” as recited in Claim 41. In the *Examiner's Answer*, the Examiner continues to point to the *Cybul* for disclosure of the recited claim elements. (*Examiner's Answer*, page 9). Appellants continue to respectfully disagree.

Appellant's claim recites a specific order to and interrelation between the steps of the claimed method. Specifically, Claim 41 recites that listing of merchandise having purchased by the customer is displayed to the customer. Claim 41 then recites that a click on a particular item of merchandise within the listing is received from a customer and that this click identifies an item for return. In contrast, the cited portion of *Cybul* merely discloses:

A POS system that supports a frequent shopper or loyalty program, a database of loyalty customers, a database of historical purchase data indexed by loyalty customer, a client/server query interface and a list builder tool with an on-line shopping history database together enable a list builder tool to efficiently find and select the past history of respective shoppers and import that data to the list builder's on-line historical purchase list database, thereby making it available for the shoppers' first and subsequent on-line shopping experiences.

(*Cybul*, col. 4, lines 25-35). Thus, the selection referred to by *Cybul* is performed by a server-based "list builder tool." The selection is not by the customer, via a web access tool. The selection is not a click on the particular item of merchandise. And, the selection does not identify a particular item of merchandise for returns processing. In fact, *Cybul* does not at all relate to returns processing. Accordingly, *Cybul* does not disclose, teach, or suggest "in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing," as recited in Claim 41. Accordingly, the recited claim elements are absent from the disclosures of *Arganbright* and *Cybul*.

Additionally, it continues to be Appellants position that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Arganbright* in view of *Cybul* to include an electronic selection from a displayed list of items to the consumer to identify an item for returns processing. *Arganbright* discloses that the process for handling returns begins when "the system presents the user with a copy of the satisfaction guarantee 2702." (*Arganbright*, Column 63, lines 3-5). Thus, the process initiates with the presentation of the return policy to the user. "After the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (*Arganbright*, Column 63, lines 8-11). Thus, the first electronic request received from the user relating to the return of a product is the selection of either a "return" button or an "exchange" button. However, this selection is received only after the customer views the return policy. The selection does not identify an item for return.

Arganbright then discloses that "[i]f the user selects "return," an online return form 2706 is presented to the user." (*Arganbright*, Column 63, lines 12-13). "The user is then

requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number.” (*Arganbright*, Column 63, lines 13-17, emphasis added). Once the return form is populated by the customer’s input, the return form is “presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user’s computer” and that the user “is requested to print the form and include the form in the box containing the product or products to be returned.” (*Arganbright*, Column 63, lines 23-29). Thus, the form must be filled out by the customer and the transaction information is provided in the box of merchandise returned by the customer. Nothing is presented to the user that would be appropriate for selection by a click on a particular item of merchandise to identify that item for returns processing.

Even when considered in conjunction with the disclosure of *Cybul*, Appellant’s claim language would not have been obvious to one of ordinary skill in the art since *Cybul* merely discloses that a shopper’s purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper’s subsequent purchases on-line. At most the *Arganbright-Cybul* combination discloses that during an online purchase, a customer’s in store purchases may be used to efficiently develop an on-line shopping list. If an item were needed to be returned after the purchase is complete, the proposed combination merely discloses that a return form could be obtained on-line and filled out by the customer on the customer’s computer, as disclosed in *Arganbright*. The form would then be printed and placed in the box for shipping. It would not have been obvious to one of ordinary skill in the art to modify the return process of *Arganbright* and the purchase process of *Cybul* to result in Appellant’s recited step of “in response to and after displaying the transaction history, receiving **an electronic selection, generated by the consumer** on the computerized system associated with the consumer, of **a particular item of merchandise** within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and **identifying the particular item of merchandise for returns processing**,” as recited in Claim 41.

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance of independent Claim 41.

- B. The proposed combination does not disclose, teach, or suggest “in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server.”**

For example, Appellants demonstrated that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest “in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server,” as recited in Claim 41. In the *Examiner’s Answer*, the Examiner continues to point to *Arganbright* for disclosure of a selection of an item and an electronic request to initiate return processing but points to *Cybul* for disclosure of the electronic selection form a list of merchandise. (*Examiner’s Answer*, page 10). Appellants continue to respectfully disagree.

Appellants’ claim recites a specific order to and interrelation between the steps of the claimed method. Specifically, Claim 41 recites that a click on a particular item of merchandise previously purchased by a customer is first received from a customer. Then, in response to that click, a returns process for the selected item of merchandise is initiated by a returns server. This combination of operations is not disclosed in the proposed *Arganbright-Cybul* combination. Additionally, Appellant’s claim does not merely recite receiving from the consumer an electronic request to initiate return processing. Appellant’s claim recites “initiating a returns process for the particular item of merchandise . . . **by a returns server,**” and this operation is not disclosed in the proposed *Arganbright-Cybul* combination.

In the Examiner’s Answer, the Examiner states that *Arganbright* teaches receiving a selection of an item . . . comprising either return or exchange of an item . . .” (*Examiner’s Answer*, page 10). However, *Arganbright* merely discloses that “[a]fter the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to “return” or “exchange” (box 2704) an item or plurality of items.” (Column 63, lines 8-11). Thus, this portion refers to the selection of either a “return” button or an “exchange” button by a user. Appellants point out that the selection of the “return” button occurs before the user populates

the form and before the user identifies a product by sku # for return. (Column 63, lines 12-22). As a result, the selection of the “return” button occurs before an item of merchandise is identified for return. Thus, the selection is not selection of an item for return. The mere presentation of form before the identification of the product to be returned is not analogous to “initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server,” as recited by Appellant’s amended Claim 41. Further, because there is no disclosure in *Arganbright* of any returns processing being initiated after the form is populated, the system of *Arganbright* cannot be said to perform any returns processing. *Arganbright* merely discloses that the form may be printed and included in the package being returned. Appellants find no disclosure of returns processing by a returns server in *Arganbright*.

Appellant also notes that *Cybul* does not at all relate to a returns process or to the processing of returns of merchandise. Even more troubling, as shown above in Section I(A) of this Response, *Cybul* does not even disclose the recited “electronic selection comprising the click on the particular item of merchandise” from the customer. The M.P.E.P. provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Because of the deficiencies of these references and the deficiencies of their proposed combination, Appellants respectfully submit that the piecemeal rejection of Appellant’s claim over the proposed *Arganbright-Cybul* combination fails to give credence to the particular combination of claim elements and the sequence of claim steps specifically recited in Appellant’s claim.

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance of independent Claim 41.

C. The proposed combination does not disclose, teach, or suggest “in response to receiving the electronic request from the computing system associated with the consumer, gathering transaction history data associated with the consumer from a computerized database.”

For example, Appellants demonstrated that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest “in response to receiving the electronic request

from the computing system associated with the consumer, gathering transaction history data associated with the consumer from a computerized database,” as recited in Claim 41. In the *Examiner’s Answer*, the Examiner continues to point to *Cybul* for disclosure of a selection of an item and an electronic request to initiate return processing but points to *Cybul* for disclosure of the electronic selection form a list of merchandise. (*Examiner’s Answer*, pages 10-11). Appellants continue to respectfully disagree.

Appellants’ claim recites a specific order to and interrelation between the steps of the claimed method. First, a return request is received via the Internet. Then, in response to that return request, transaction history data associated with the customer is gathered from a computerized database. Appellant respectfully submits that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest the features and operations recited in Appellants’ claim.

Rather, *Cybul* relates to a “a frequent shopper or loyalty program”. (*Cybul*, Column 4, lines 25-34; Column 1, lines 63-65; Abstract). As a result, a list builder tool can “efficiently find and select the past shopping history of respective shoppers and import that data to the list builder’s on-line historical purchase list database, thereby making it available for the shoppers’ first and subsequent on-line shopping experiences.” (*Cybul*, Column 4, lines 29-34; Abstract). As such, although *Cybul* discloses “access[ing] a customer’s shopping history from a selected POS system” (*Cybul*, Column 4, lines 40-50), *Cybul* merely discloses that a shopper’s purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper’s subsequent purchases on-line. *Cybul* does not at all relate to a returns process and, thus, does not disclose, teach, or suggest gathering transaction history data associated with the customer from a computerized database “*in response to receiving the electronic request from the computing system associated with the consumer, gathering transaction history data associated with the consumer from a computerized database.*”

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance of independent Claim 41.

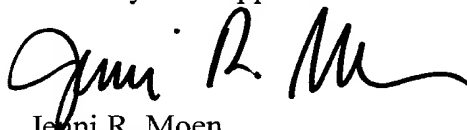
CONCLUSION

Appellant has demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellant respectfully requests the Board to reverse the final rejections and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

No fees are believed due; however, the Commissioner is authorized to charge any additional fees or credits to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Appellant

A handwritten signature in black ink, appearing to read "Jenni R. Moen", is written over the printed name.

Jenni R. Moen
Reg. No. 52,038
(214) 415-4820

Dated: November 2, 2009

Correspondence Address:

at Customer No. **05073**